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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,138	12/29/2000	Dale W. Malik	BS00-170	6782

7590

05/23/2005

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EXAMINER

PHAN, TAM T

ART UNIT

PAPER NUMBER

2144

DATE MAILED: 05/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/750,138

Applicant(s)

MALIK, DALE W.

Examiner

Tam (Jenny) Phan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6-8,15 and 21-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6-8,15 and 21-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/25/2005 has been entered.

2. This application has been examined. Amendment received on 09/23/2004 has been entered. Claims 1-3, 21-22, 34-36, and 42 are currently amended. Claims 4-5, 9-14, 16-20, 24-25, and 29 are cancelled. Claims 6-8, 15, 23, 26-28, 30-33, 37-41 are previously presented.

3. Claims 1-3, 6-8, 15, 21-23, 26-28, and 30-42 are presented for examination.

Priority

4. No priority claims have been made.

5. The effective filing date for the subject matter defined in the pending claims in this application is 12/29/2000.

Claim Objections

6. Claims 1-3 are objected to because of the following informalities: "A method for a Simple Mail Transfer Protocol" (claim 1 lines 1-2) should read "A method for managing a Simple Mail Transfer Protocol". "SMTP the electronic mail server application" (claim 2 lines 2-3) should read "the SMTP electronic mail server application". "checking is performed when the SMTP electronic mail message is performed periodically" (claim 3

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lines 2-3) should read "checking is performed when the SMTP electronic mail message is received periodically" or "checking is performed periodically when the SMTP electronic mail message is received".

7. Appropriate correction is required.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-3, 6-8, 15, 21-23, 26-28, and 30-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnold (U.S. Patent Number 6,275,848) in view of Lafe et al. (U.S. Patent Number 6,449,658), hereinafter referred to as Lafe.

10. Regarding claim 1, Arnold disclosed a method for managing a Simple Mail Transfer Protocol (SMTP) electronic mail server application on a host computer (Figure 1 signs 104 & 108, Figure 4, column 1 lines 39-57, column 4 lines 6-23), comprising the steps of: checking an SMTP electronic mail message against a predetermined criteria (Figure 4, column 1 lines 39-57, column 4 lines 6-23); and compacting the SMTP electronic mail message if the predetermined criteria is satisfied (Abstract, Figures 2&4, column 1 lines 39-57, column 3 lines 45-62, column 4 lines 6-23).

11. Arnold taught the invention substantially as claimed. However, Arnold did not expressly teach compacting a non-attachment portion of the SMTP electronic mail message.

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12. Arnold suggested exploration of art and/or provided a reason to modify the managing electronic mail method with additional feature such as compacting the content of the electronic message (column 1 lines 26-37, column 1 line 63-column 2 line 13).

13. Lafe disclosed a method for managing electronic messages wherein the attachment and non-attachment portion of the SMTP electronic message is compacted (Abstract, Figures 5, 6A1, 7A-7B, column 5 lines 28-42, lines 53-54, column 6 lines 39-67, column 7 lines 11-13, column 8 lines 23-32).

14. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Arnold with the teachings of Lafe to include the message content compaction feature in order to efficiently move information across a network (Lafe, Abstract) since seamless transport engine to move data quickly through the Internet is essential (column 1 lines 37-42).

15. Regarding claim 2, Arnold disclosed a method wherein the step of checking is performed when the SMTP electronic mail message is received by the SMTP electronic mail server application [message switch] (Figures 1-2, column 1 lines 39-57, column 2 lines 27-37, column 3 lines 45-50).

16. Regarding claim 3, Arnold disclosed a method wherein the step of checking is performed periodically when the SMTP electronic mail message is received on the host computer (column 1 lines 39-57, column 2 lines 42-50, column 4 lines 9-19).

17. Regarding claim 6, Arnold disclosed a method wherein the predetermined criteria comprises a total message size (column 4 lines 12-19).

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18. Regarding claim 7, Arnold disclosed a method wherein the predetermined criteria comprises an attachment size [configurable factors] (column 1 lines 45-57, column 4 lines 12-17, lines 64-67).

19. Regarding claim 8, Arnold disclosed a method wherein the predetermined criteria comprise an attachment type [configurable factors] (column 5 lines 16-18, column 4 lines 12-17).

20. Regarding claim 15, Arnold disclosed a method further comprising the step of compressing the attachment (column 1 lines 38-41).

21. Regarding claim 21, Arnold and Lafe combined disclose a method for managing a user's Simple Mail Transfer Protocol (SMTP) electronic mailbox on a computer, comprising the steps of: checking an SMTP electronic mail message against a predetermined criteria (Arnold, Figure 4, column 1 lines 39-57, column 4 lines 6-23); and compressing a non-attachment portion of the SMTP electronic mail message if the predetermined criteria is satisfied, wherein the step of compressing the SMTP electronic mail message is performed by searching for repeated patterns in the SMTP electronic mail message and encoding those patterns (Arnold, Abstract, Figures 2&4, column 1 lines 39-57, column 3 lines 45-62, column 4 lines 6-23; Lafe, Abstract, Figures 5, 6A1, 7A-7B, column 5 lines 28-42, lines 53-54, column 6 lines 39-67, column 7 lines 11-13, column 8 lines 23-32).

22. Regarding claim 22, Lafe disclosed a method wherein the step of checking is performed when the SMTP electronic mail message is received by the SMTP electronic mailbox (column lines 39-59, column 6 lines 60-67).

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23. Regarding claim 23, Arnold disclosed a method wherein the step of checking is performed upon request by the user (column 2 line 56-column 3 line 2, column 4 lines 58-67).
24. Regarding claim 26, Arnold disclosed a method wherein the predetermined criteria comprises a total message size (column 4 lines 6-23).
25. Regarding claim 27, Arnold disclosed a method wherein the predetermined criteria comprises an attachment size (column 4 lines 6-24).
26. Regarding claim 28, Arnold disclosed a method wherein the predetermined criteria comprises an attachment type (column 4 lines 6-24).
27. Regarding claim 30, Arnold disclosed a method wherein the location of the screening of the message is on a server (Figure 1, column 3 lines 45-56, column 4 lines 6-24).
28. Regarding claim 31, Lafe disclosed a method wherein the location of the screening of the message is on a client (column 6 lines 60-67).
29. Regarding claim 32, Arnold disclosed a method wherein the location of the screening of the message is configured by a user (column 2 line 56-column 3 line 2, column 4 lines 58-67).
30. Regarding claim 33, Arnold disclosed a method wherein the screening is performed periodically on the computer (column 6 lines 13-33).
31. Regarding claim 34, Lafe disclosed a method wherein the SMTP electronic mail message is compressed into a compressed file using various compression algorithms

[zipped file]. Note: Zip compression algorithms are well known in the art at the time of the invention was made (column 5 lines 28-43). Refer to PTO-892 for prior art of record.

32. Regarding claims 35-42, the computer readable medium with logic embedded therein for executing on a computer for managing a user's electronic mailbox corresponds directly to the method of claims 21-23, 26-8, and 30-34, and thus these claims are rejected using the same rationale.

33. Since all the limitations of the claimed invention were disclosed by the combination of Arnold and Lafe, claims 1-3, 6-8, 15, 21-23, 26-28, and 30-42 are rejected.

34. Claims 1-3, 6-8, 15, 21-23, 26-28, and 30-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beyda et al. (U.S. Patent No. 6,275,850), hereinafter referred to as Beyda, in view of Hanson et al. (U.S. Patent Number 6,549,957), hereinafter referred to as Hanson, and further in view of Postel ("Simple Mail Transfer Protocol" RFC 821).

35. Beyda disclosed a method for automatically managing an electronic mail server application on a host computer, said method comprising the steps of checking an electronic mail message against a predetermined criteria (Figure 3, column 2 lines 42-63).

36. Beyda taught the invention substantially as claimed. However, Beyda did not expressly teach compacting a non-attachment portion of the electronic mail message if the predetermined criterion is satisfied.

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37. Beyda suggested exploration of art and/or provided a reason to modify the method with the compacting the electronic message to minimize downloading time (Figure 3, column 1 lines 49-55).

38. Hanson disclosed a method for managing electronic messages wherein the non-attachment portions of the electronic mail message are compacted (Figures 4A-4B, 6, 7A-7B, 8, column 5 lines 31-51, column 10 lines 54-column 11 lines 17).

39. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Beyda with the teachings of Hanson to include the non-attachment compaction feature in order to reduce the size of the message (Hanson, column 5 lines 32-41, column 10 line 55-column 11 line 3) since accessing email messages may lead to an unproductive waiting period (Beyda, column 1 lines 47-49).

40. Beyda and Hanson combined taught the invention substantially as claimed. However, the combined method of Beyda and Hanson did not expressly teach the use of Simple Mail Transfer Protocol as a mechanism for the transmission of electronic mail.

41. Postel disclosed Simple Mail Transfer Protocol for transferring electronic mail reliably and efficiently (Postel, Title, page 2 section 1. Introduction, pages 2-3 section 2. The SMTP Mode).

42. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combined method of Beyda and Hanson with the teachings of Postel to use SMTP in order to transfer mail reliably and efficiently (page 2 section 1. Introduction paragraph 1) since SMTP is independent of the particular

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transmission subsystem and requires only a reliable ordered data stream channel (page 2 section 1. Introduction paragraph 2).

43. Regarding claim 2, Beyda and Postel disclosed a method wherein the step of checking is performed when the SMTP electronic mail message is received by the electronic mail server application (Beyda, Figure 3, column 2 lines 42-50, column 4 lines 9-23; Postel, Title, page 2 section 1. Introduction, pages 2-3 section 2. The SMTP Mode).

44. Regarding claim 3, Beyda disclosed a method wherein the step of checking is performed periodically when the SMTP electronic mail message is received on the host computer (Beyda, Figure 3, column 2 lines 42-50, column 4 lines 9-23; Postel, Title, page 2 section 1. Introduction, pages 2-3 section 2. The SMTP Mode).

45. Regarding claim 6, Beyda disclosed a method wherein the predetermined criteria comprise a total message size (Figure 3 sign 58, column 2 lines 51-63, column 4 lines 36-61).

46. Regarding claim 7, Beyda disclosed a method wherein the predetermined criteria comprise an attachment size (Figure 3 sign 58, column 2 lines 51-63, column 4 lines 36-61).

47. Regarding claim 8, Beyda disclosed a method wherein the predetermined criteria comprise an attachment type (Figure 3 sign 62, column 2 lines 51-63, column 3 lines 4-13).

48. Regarding claim 15, Hanson disclosed a method further comprising the step of compressing the attachment (column 11 lines 4-17).

49. Regarding claim 21, Beyda, Hanson, and Postel combined disclose a method for managing a user's Simple Mail Transfer Protocol (SMTP) electronic mailbox on a computer, comprising the steps of: checking an SMTP electronic mail message against a predetermined criteria (Beyda, Figure 3, column 2 lines 42-63; Postel, Title, page 2 section 1. Introduction, pages 2-3 section 2. The SMTP Mode); and compressing a non-attachment portion of the SMTP electronic mail message if the predetermined criteria is satisfied, wherein the step of compressing the SMTP electronic mail message is performed by searching for repeated patterns in the SMTP electronic mail message and encoding those patterns (Hanson, Figures 4A-4B, 6, 7A-7B, 8, column 5 lines 31-51, column 10 lines 54-column 11 lines 17; Postel, Title, page 2 section 1. Introduction, pages 2-3 section 2. The SMTP Mode).

50. Regarding claim 22, Beyda and Postel disclosed a method wherein the step of checking is performed when the SMTP electronic mail message is received by the SMTP electronic mailbox (Beyda, Figure 3, column 5 line 59-column 6 line 5; Postel, Title, page 2 section 1. Introduction, pages 2-3 section 2. The SMTP Mode).

51. Regarding claim 23, Beyda disclosed a method wherein the step of checking is performed upon request by the user (column 4 lines 45-61, column 6 lines 35-49).

52. Regarding claim 26, Hanson disclosed a method wherein the predetermined criteria comprises a total message size (column 10 line 54-column 11 line 17).

53. Regarding claim 27, Beyda disclosed a method wherein the predetermined criteria comprises an attachment size (Abstract, Figure 3, column 3 lines 4-13).

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54. Regarding claim 28, Beyda disclosed a method wherein the predetermined criteria comprises an attachment type (Abstract, Figure 3, column 3 lines 4-13).

55. Regarding claim 30, Beyda disclosed a method wherein the location of the screening of the message is on a server (Figure 3, column 5 line 59-column 6 line 5).

56. Regarding claim 31, Hanson disclosed a method wherein the location of the screening of the message is on a client (column 10 line 54-column 11 line 17).

57. Regarding claim 32, Beyda disclosed a method wherein the location of the screening of the message is configured by a user (column 6 lines 35-49, column 7 lines 23-29, lines 40-45).

58. Regarding claim 33, Beyda and Hanson disclosed a method wherein the screening is performed periodically on the computer (Beyda, Figure 3, column 3 lines 31-35; Hanson, column 5 lines 31-51, column 10 line 54-column 11 line 3).

59. Regarding claim 34, Hanson and Postel disclosed a method wherein the SMTP electronic mail message is compressed into a zipped file (Hanson, Figures 4A-4B; Postel, Title, page 2 section 1. Introduction, pages 2-3 section 2. The SMTP Mode).

60. Regarding claims 35-42, the computer readable medium with logic embedded therein for executing on a computer for managing a user's electronic mailbox corresponds directly to the method of claims 21-23, 26-8, and 30-34, and thus these claims are rejected using the same rationale.

61. Since all the limitations of the claimed invention were disclosed by the combination of Beyda, Hanson, and Postel, claims 1-3, 6-8, 15, 21-23, 26-28, and 30-42 are rejected.

Response to Arguments

62. Applicants' arguments filed 04/25/2005 with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

63. In response to applicant's argument regarding the Simple Mail Transfer Protocol (SMTP) feature, the Examiner has carefully reviewed the specification of the instant application and SMTP was only mentioned in the background section of the specification as "Any suitable protocol, for example, Simple Mail Transfer Protocol ("SMTP"), can be used to coordinate different mail server applications" (page 1 lines 19-20). There was no other disclosure or teaching in the abstract, drawings, or specification that would teach using SMTP in the claimed invention. However, the Examiner recognizes that SMTP is one of the industry conventional and de facto protocols for transferring electronic mail reliable and efficiently since 1982 (See RFC 821). Thus, the Examiner will not object the SMTP feature as a limitation that introduces new matter into the disclosure. Accordingly, the use of SMTP in electronic mail message system was well known at the time of the invention. However, to advance prosecution, the Examiner has prepared new ground of rejections that taught all the claimed limitations as currently presented including the amended SMTP feature. Refer to the above rejection for details.

64. The Examiner also recognizes that applicant might have overlooked some of the critical points that were discussed during the telephone interview (02/11/2005). The Interview Summary description is shown below for applicant's convenience. The discussions regarding compaction/compression non-attachment portion of the e-mail and their interpretations were and still are of great importance to the prosecution of the

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claimed invention.

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Applicant initiated interview to further prosecution by attempting to understand Examiner positions and potentially locate some allowable subject matter. The invention was described by Applicant to involve electronic mail (e-mail) compacting (presumed generally/broadly compression) of non-attachment e-mail data. Further provision for compacting/compressing attachment data is also present in the claims. Examiner recognized extreme breadth of the independently claimed invention and provided multiple interpretations which may not be commensurate with the disclosed specification, including, for example, e-mail header compression, and text block URL replacement, both of which compact/compress non-attachment portions of the e-mail. Definition for what constitutes an "electronic mail message" was raised, including HTML web pages delivered from POP server(s) using HTTP, and standard e-mail delivered via SMTP. Examiner suggested elaboration of a definite e-mail description, potentially in accordance with well known e-mail formats including Request for Comments 821 and 822, which defined e-mail in the 1980s and remains conventional. Other interpretations included the compression of e-mail headers (clearly non-attachment data), and compression of the entirety of the message (which includes compacting of non-attachment data also). Applicant was encouraged to amend the claims with further defining language in order to limit the scope of search to particularly relevant area(s). Distinguishing over the prior art of record will be determined in response to further submissions.

65. As the rejection reads, Examiner asserts that the combination of these teachings render the claimed invention obvious.

Conclusion

66. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Refer to the enclosed PTO-892 for details.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tam (Jenny) Phan whose telephone number is (571) 272-3930. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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